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PATENT TRADEMARK OFFICE

PATENT
Customer Number 22,852
Attorney Docket No. 5725.0435-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#17
MST
6-21-02

In re Application of:)
)
G. Lang et al.) Group Art Unit: 1751
)
Application No.: 09/350,579) Examiner: M. Einsmann
)
Filed: July 8, 1999)

For: COMPOSITION FOR DYEING KERATIN FIBRES WITH A CATIONIC
DIRECT DYE AND A THICKENING POLYMER

RECEIVED

Assistant Commissioner for Patents
Washington, DC 20231

JUN 20 2002

TC 1700

Sir:

SUBMISSION UNDER 37 C.F.R. § 1.114

This paper is filed concurrently with a Request for Continued Examination (RCE).
This submission and the RCE are timely filed in view of the Notice of Appeal filed
November 21, 2001 and the Petition for Extension of Time (five months) filed herewith.

REMARKS

I. Disposition of the Claims

Claims 1-68, 70-74, 76, 77, 79-106, 108, and 109 are pending and are subject
to a restriction requirement. Claims 1-5, 7, 8, 14-31, 62-68, 70-74, 76, 77, 79-83,
108, and 109 stand rejected. Claims 6, 9-13, 32-61, and 84-106 stand withdrawn
from consideration.

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II. Rejections Under 35 U.S.C. § 103(a)

Over Jones in view of Rondeau

The Office rejected claims 1-5, 7, 8, 14-19, 24, 31, 62-68, 70-74, 76, 77, 79-83, 108, and 109 as being obvious over the teachings of Jones (U.S. Pat. No. 6,106,578) in view of those of Rondeau (U.S. Pat. No. 5,879,412). Filed with this paper is a Rule 1.131 Declaration of Gérard Lang and Jean Cotteret that establishes that a reduction to practice of the claimed invention occurred before the filing date of the Jones patent. Please note that the line that appears on p. 2, line 2 of the Declaration is a result of the document being faxed, and is not intended to cross anything out. As a result, Jones cannot be used as a reference under 35 U.S.C. § 103(a), as Jones was filed after the claimed invention was made. *Cf. M.P.E.P.* § 715.02. Thus, this rejection should be withdrawn.

Over de la Mettrie in view of Rondeau

The Office rejected claims 1-5, 7, 8, 14-31, 62-68, 70-74, 76, 77, 79-83, 108, and 109 as being obvious over the teachings of de la Mettrie (U.S. Pat. No. 6,010,542) in view of those of Rondeau. Applicants respectfully traverse this rejection.

The rejection is improper, and should be withdrawn, because the Office's motivation to combine the teachings of the references ignores too many facts and thus never considers the cited documents in their entirety. *Cf. M.P.E.P.* § 2142. The factual inquiry whether to combine references must not only be thorough and searching but also be based on objective evidence of record. *See In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Particular findings must be made concerning the reason one of ordinary skill in the art, with no knowledge of the claimed invention, would have selected

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the ingredients for combination in the manner claimed. See *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The findings must be supported by "clear and particular" evidence flowing, *inter alia*, from the references themselves. See *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Such is not the case in this rejection.

In this rejection, de la Mettrie, as the Office admitted, fails to teach adding the cationic dyes of Rondeau to its compositions. See Office Action of 5/23/01, p. 7. According to the Office, one of ordinary skill in the art would have been motivated to "add a direct dye as claimed ... to the compositions of de la Mettrie, which contain oxidation bases, couplers, oxidants and nonionic amphiphilic polymers as claimed." See Office Action of 10/4/00, p. 10. Yet the Office's motivation to combine under each alternative is insufficient to support a *prima facie* case of obviousness, and its reliance upon *In re Kerkhoven*, 205 USPQ (CCPA 1980) is improper.

A. There is no motivation to "add a direct dye as claimed ... to the compositions of de la Mettrie."

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *M.P.E.P.* § 2143.01 (emphasis in original). According to the Office, "de la Mettrie teaches that direct dyes, including azo dyes, may be used in admixture with the patentee's oxidation dyes, ... and Rondeau teaches that the direct dyes are compatible with nonionic polymers (de la Mettrie's required additives)." See Office Action of 10/4/00, p. 11. But even if it were conventional to add direct dyes to oxidative compositions optionally comprising nonionic polymers, that would be distinct

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from explaining why one of ordinary skill in the art would have been motivated to select particular teachings of Rondeau and de la Mettrie to combine them as proposed.

de la Mettrie's azo dyes are not necessarily the cationic direct dyes of Rondeau, and Rondeau's nonionic polymers are not necessarily the nonionic amphiphilic polymers of de la Mettrie. de la Mettrie's class of azo dyes is too big to suggest all of its members. See *M.P.E.P.* § 2144.08. Some desirable reason must exist to choose the particular cationic direct dyes of Rondeau for combination with the compositions of de la Mettrie comprising de la Mettrie's nonionic amphiphilic polymer.

Along these lines, Rondeau never "teaches that the claimed cationic direct dyes result in improved endurance and glints when added to oxidative hair dyeing compositions." See Office Action of 5/23/00, p. 8. According to Rondeau, its **compositions** make it possible to obtain radiant colorations that are rich in glints while at the same time with good endurance properties. See Rondeau, col. 1, ll. 59-64. There is no basis to attribute the properties of Rondeau's entire composition to a single component. Thus, these teachings would not be a reason why one of ordinary skill in the art, with no knowledge of the claimed invention, would have selected the particular cationic direct dyes of Rondeau for combination with the compositions of de la Mettrie comprising de la Mettrie's nonionic amphiphilic polymer.

Indeed, a whole host of nonionic, cationic, and anionic direct dyes were available to choose from at the time the claimed invention was made. For example, a partial list would have included at least the following direct dyes: nonionic, cationic, and anionic azo dyes; nonionic, cationic, and anionic anthraquinone dyes; nonionic, cationic, and anionic naphthoquinone dyes; nonionic, cationic, and anionic nitrobenzene dyes;

cationic triarylmethane dyes; cationic azomethine dyes; and arianors. de la Mettrie never mentions any specific direct dye, although it generally mentions nitro, azo, and anthraquinone dyes. See de la Mettrie, col. 7, ll. 32-33. Yet the Office focused upon those direct dyes of Rondeau, even though Rondeau never mentions de la Mettrie's nonionic amphiphilic polymer.

In any case, by stating adding direct dyes to oxidation compositions was conventional, the Office merely noted that each ingredient of the claimed invention can be found in at least one of the cited references. But a motivation to combine teachings of various references cannot be established by merely implying one of ordinary skill in the art is capable of creating the claimed invention from bits and pieces of the documents of record. See *M.P.E.P.* § 2143.01. Nor can the motivation be established by discussing how the teachings of the references may allegedly be combined. See *id.* A prima facie case of obviousness requires a basis for the desirability of, or in other words the motivation for, the proposed combination. See *id.* Thus, this rejection is improper and should be withdrawn.

B. The Office's reliance upon *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980) is improper.

According to the Office, "[i]t is *prima facie* obvious to combine two compositions each taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose." See Office Action of 5/23/01, p. 8. Yet the reasoning of *Kerkhoven* does not apply to reactive compositions, such as the one proposed by the Office. In *Kerkhoven*, applicant claimed a process for preparing a detergent composition comprising merely mixing a pair of detergents for the

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purpose of optimizing a detergent composition. See *Kerkhoven*, 205 USPQ at 1070. The predecessor court to the Federal Circuit concluded that applicant's claims require no more than the mere mixing two conventional detergents, each taught for the same purpose, to form a third detergent. See *id.* at 1071.

But that is not the case here. While the method of *Kerkhoven* merely mixed two detergents, the proposed composition would not be a mere mixture. The proposed composition would contain a reactive oxidation dye. Thus, unlike the situation in *Kerkhoven*, the Office's proposed composition would be reactive and not a mere mixture. The reasoning of *Kerkhoven* does not apply to the facts of this rejection.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of the pending claims and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Sean A. Passino
Reg. No. 45,943

Dated: June 17, 2002

Enclosures: *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

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